

REMARKS/ARGUMENTS

Reconsideration of the application is requested.

Claims 1-3, 6-15, 18-19, and 21-22 remain in the application. Claims 1-3 and 14 have been amended. Claims 4-5, 16-17, and 20 have been cancelled.

In item 2 on page 2 of the above-identified Office action, claims 4-5 and 16-17 have been rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

More specifically, the Examiner has stated that the limitation of "long ceramic fibers" is nowhere disclosed in the specification of the priority documents.

Claims 4-5 and 16-17 have been cancelled.

In item 3 on page 2 of the above-identified Office action, claims 4-5 and 16-17 have been rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not

described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

More specifically, the Examiner has stated that it is unclear what is intended by "long ceramic fibers" and how long the fibers must be to be considered "long ceramic fibers".

Claims 4-5 and 16-17 have been cancelled.

In item 5 on pages 2-3 of the above-identified Office action, claims 2-5, 8, 14, and 16-17 have been rejected as being indefinite under 35 U.S.C. § 112, second paragraph.

More specifically, the Examiner has stated that in claims 2, 8, and 14, the language of the claims is directed to a method of making which renders the claim vague and indefinite as it is unclear as to what structural limitation Applicant is attempting to recite.

The language of claims 2 and 14 has been amended to even more clearly recite a structure limitation. The language of claim 8 is believed to be definite because a person skilled in the art would clearly understand the structural difference between a layer wound once around the honeycomb element and a layer

wound more than once around the honeycomb element. The Examiner is requested to suggest any language he believes recites the limitation more clearly.

The Examiner has further stated that the word "low" in claim 3 and the word "long" in claim 4 are relative terms and are therefore vague and indefinite. The word "low" has been deleted from claim 3. Claim 4 has been cancelled.

It is accordingly believed that the specification and the claims meet the requirements of 35 U.S.C. § 112, first and second paragraphs. Should the Examiner find any further objectionable items, counsel would appreciate a telephone call during which the matter may be resolved. The above-noted changes to the claims are provided solely for cosmetic and/or clarificatory reasons. The changes are neither provided for overcoming the prior art nor do they narrow the scope of the claims for any reason related to the statutory requirements for a patent.

In item 7 on pages 3-4 of the above-mentioned Office action, claims 1-3, 7-8, 12-15, and 19 have been rejected as being anticipated by Locker et al. (US Pat. No. 6,077,483) under 35 U.S.C. § 102(e).

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claims 1 and 12 call for, inter alia:

the compensating layer being wound around the honeycomb element.

The Examiner has cited column 7, lines 14-53 of Locker et al. as disclosing how the intumescent mat is wrapped (wound) around the honeycomb element. However, claims 1 and 12 of the instant application are not directed to the fact that the swelling mat is wound around the honeycomb element, but the fact that the compensating layer is wound around the honeycomb element. The intumescent mat as disclosed in Locker et al. is not an equivalent of the compensating layer as disclosed in the invention of the instant application.

The Examiner has also stated that the method of how to locate the mat between the honeycomb element and the casing is irrelevant in apparatus claims as long as the mat is

positioned between the honeycomb element and the casing.

Applicant respectfully disagrees. According to common patent practice, a product feature can be defined in any manner so long it is clearly perceivable in the final product. It is not improper to define a product feature by a process although the patentability of a product-by-process claim is based on the structure implied by the process. In this case, the method used to locate the compensating layer between the casing and the honeycomb element does make a difference in the structure of the final product.

Clearly, Locker et al. do not show the compensating layer being wound around the honeycomb element, as recited in claims 1 and 12 of the instant application.

Claims 1 and 12 are, therefore, believed to be patentable over Locker et al. and since claims 2-3, 7-8, 12-15, and 19 are ultimately dependent on claims 1 or 12, they are believed to be patentable as well.

In item 11 on pages 5-6 of the above-mentioned Office action, claims 4-5 and 16-17 have been rejected as being unpatentable over Locker et al. in view of Merry (US Pat. No. 4,929,429) under 35 U.S.C. § 103(a).

Claims 4-5 and 16-17 have been cancelled.

In item 12 on pages 6-7 of the above-mentioned Office action, claims 6 and 18 have been rejected as being unpatentable over Locker et al. in view of Ten Eyck (US Pat. No. 4,999,168) under 35 U.S.C. § 103(a).

As discussed above, claims 1 and 12 are believed to be patentable over the art. Since claims 6 and 18 are dependent on claims 1 or 12, they are believed to be patentable as well.

In item 13 on page 7 of the above-mentioned Office action, claims 9-11 and 21-22 have been rejected as being unpatentable over Locker et al. in view of Santiago et al. (US Pat. No. 4,344,922) and Ten Eyck under 35 U.S.C. § 103(a).

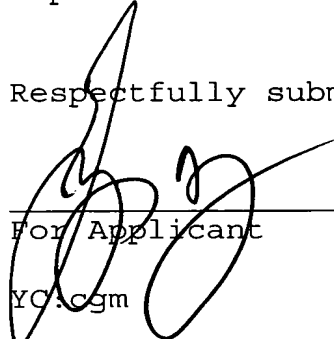
As discussed above, claims 1 and 12 are believed to be patentable over the art. Since claims 9-11 and 21-22 are ultimately dependent on claims 1 or 12, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1-3, 6-15, 18-19, and 21-22 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate a telephone call so that, if possible, patentable language can be worked out. In the alternative, the entry of the amendment is requested as it is believed to place the application in better condition for appeal, without requiring extension of the field of search.

If an extension of time for this paper is required, petition for extension is herewith made. Please charge any fees which might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Respectfully submitted,



For Applicant

Gregory L. Mayback
Reg. No. 40,719

YC:ogm

December 8, 2003

Lerner and Greenberg, P.A.
Post Office Box 2480
Hollywood, FL 33022-2480
Tel: (954) 925-1100
Fax: (954) 925-1101